

### III. REMARKS

#### A. Status of the Claims

Claims 1, 3-7 and 11-12, 16 and 23-24 are pending. Claims 13, 15 and 17-22 have been cancelled without prejudice. Claims 1, 11, 17, 20 and 23 have been amended. Support for the amendments can be found throughout the specification, e.g., the originally filed claims. It is respectfully submitted that no new matter has been added by virtue of this amendment.

#### B. Withdrawal of Claims 3, 5, 13, 15, and 17-22

The Examiner indicated that claims 3, 5, 13, 15 and 17-22 were withdrawn from further consideration as being directed to a non-elected invention.

It is respectfully submitted that the search of the elected species, i.e., 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino ethyl was expanded to include 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino propyl as indicated by the Examiner in the Office Action mailed October 2, 2001.

It is respectfully submitted that claims 3 and 5 read on a species that has been searched by the Examiner, i.e., 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino propyl. Claim 3 recites a compound of claim 1 wherein R<sub>2</sub> is butyl, corresponding to the 'dibutylamino propyl' moiety of the searched species and claim 5 recites a compound of claim 1 wherein R<sub>5</sub> is phenyl, corresponding to the '2-phenyl-1-oxo-ethyl' moiety of the searched species. Accordingly, removal of the Examiner's withdrawal of claims 3 and 5 is respectfully requested.

#### C. Rejection under 35 U.S.C. § 102 (b)

The Examiner rejected claims 1, 4, 7, 11, 12, 14, 16 and 23-24 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,590,271 to Shiokawa, et al (the '271 patent). The Examiner indicated that compound II of the '271 patent anticipates the invention when R<sub>4</sub> is a bond, R<sub>5</sub> is hydrogen, R<sub>1</sub> is a C<sub>3</sub> alkyl, R<sub>2</sub> and R<sub>3</sub> are hydrogen, n is 1 and R<sub>6</sub> is halogen.

In response, claim 1 has been amended to delete halogen as a possible substitution at R<sub>6</sub>;

claim 11 has been amended to delete hydrogen as a possible substitution at R<sub>2</sub>; and claim 23 has been amended to delete hydrogen as a possible substitution at R<sub>3</sub>. Therefore, the Examiner is respectfully requested to remove the rejection of claims 1, 11 and 23 under 35 U.S.C. 102(b).

**D. Claim Objections**

The Examiner indicated that claim 6 was allowable, but objected to as being dependent on a rejected base claim. It is respectfully submitted that the rejection to independent claim 1 has been obviated and removal of the Examiner's objection is respectfully requested.

**IV. CONCLUSION**

In view of the arguments presented, it is respectfully submitted that this application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited. The Examiner is invited to contact the undersigned at the telephone number provided below if it is determined that any further issues remain.

Respectfully Submitted,  
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